

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 2-19, independent claim 21, and independent claim 22 will be present in the application.

Claims 1 and 22 have been amended to recite that the light source comprises a plurality of flashtube assemblies. Claim 4 has been amended to delete this limitation. Claims 1 and 22 have also been amended to recite that an infrared filter is disposed intermediate the light source and the optical probe. Such apparatus is described on page 9, lines 15-26, and shown in Figure 1. Claim 19 has been amended to recite that "the fourth flashtube assembly to paint the target area and clearly mark an area of intervention on the video monitor." Such apparatus is described on page 16, lines 14-18. Accordingly, the amendments do not introduce any new matter.

Claim 20 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 20 has been canceled. Accordingly, the rejection is moot. Claim 19 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 has been amended to overcome the rejection.

Claims 1, 2 and 22 rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 6,293,911 (Imaizumi). Claim 1 has been amended to recite that the second service cable assembly defines "a light path having an infrared filter disposed therein". Claim 22 has been amended to recite that the micro-endoscopic device includes "an infrared filter disposed intermediate the light source and the optical probe".

The Imaizumi reference discloses an endoscope system that utilizes Near Infrared light to detect fluorescence in the visible spectrum. Such a system could not operate if it were to include the infrared filter now recited in claims 1 and 22. Accordingly, Imaizumi does not now and could not be modified to include an infrared filter.

Claims 1-3 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 6,468,204 (Sendai). Claims 4-8, 12-16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sendai in view of U.S. 4,253,447, Re. 31,289 (Moore et al.), and in further view of U.S. 6,679,838 (Bala). Claims 9-11 are rejected under 35 USC 103(a)

as being unpatentable over Sendai in view of U.S. 5,278,639 (Fort). Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sendai in view of Moore and Bala, and in further view of U.S. 6,485,414 (Neuberger).

Claim 1 has been amended to recite that the light source comprises "a plurality of flashtube assemblies" and that the second service cable assembly defines "a light path having an infrared filter disposed therein". Claim 22 has been amended to recite that the light source comprises "a plurality of flashtube assemblies" and that the micro-endoscopic device includes "an infrared filter disposed intermediate the light source and the optical probe". Accordingly, the rejection under 35 U.S.C. 102(b) must be withdrawn.

"It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." Northern Telecom Inc. v. Datapoint Corp., 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). "There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985). "To properly combine the references to reach the conclusion that the subject matter ... would have been obvious, case law requires that there must have been some teaching, suggestion, or inference in either reference, or both, or knowledge generally available to one of ordinary skill in the art to combine the relevant teachings of the references. When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper." Ex parte Skinner, 2 USPQ2d 1788, 1790 (B. Pat. App. & Int. 1986). The Office Action alleges that the required teaching, suggestion or incentive may be found in the prior art. Specifically, the Office Action contends that "it would have been obvious ... that the "white light source 114" disclosed by Sendai be replaced with the "light handling section 12" disclosed by Moore such that Sendai's invention is made "capable of producing a readout signal containing full color image information that is compatible with standard format television" (Moore's abstract). Sequential illumination of RGB light is a well-known alternative to continuous white illumination; it better allows for NTSC compatibility, a feature that is clearly advantageous to a skilled artisan." The Office Action also contends that "it would have been obvious ... that Sendai be modified to include a filter which

removes infrared components from the light source in order to thermally protect the endoscope.”

The Applicant respectfully submits that the Office Actions allegations reasons for modifying the Sendai apparatus to include both flashtubes and an infrared filter are not supported by fact. The Fort reference discloses the use of an arc lamp as the light source and teaches that great care must be taken to remove the heat generated by this lamp, including the anti-heat device 20 cited in the Office Action (Col. 3, lines 42-56). The subject application teaches that conventional endoscopes having continuous wave light sources are known to generate so much heat within the probe to ignite disposable paper drapes conventionally used during surgery. However, the multiple flashtubes recited in claims 1, 21 and 22 do not produce light that will generate heat within the probe that is sufficient to harm a patient or to ignite the surgical drapes. Page 10, lines 15-18. Therefore, there is no incentive to add any component to the endoscope to reduce the production of heat within the probe. As taught in the subject application, “[a]n infrared (IR) filter 36 and a removable ultra violet (UV) filter 38 is provided to remove IR and UV energy from the light carried in the fiber optic bundle during imaging to protect body tissue.” Page 9, lines 19-22. Such tissue damage would be due to absorption of the light energy by the tissue, rather than by heat energy emitted by the endoscope probe. Since the Office Action does not provide a valid reason as to why it would be obvious to modify the Sendai apparatus to include both flashtubes and an infrared filter, claims 1, 21 and 22 are not obvious in view of the cited art.

The various dependent claims add additional features to the independent claims, and are therefore believed to be allowable. Also, the dependent claims are believed patentably distinct on their own merits as being directed to combinations not suggested by the references. For example, the Office Action alleges that “laser light source 7 disclosed by Imaizumi inherently has some activation interface The activation interlace further composes the claimed control module.” The Applicant respectfully submits that there is no logical basis for such allegation.

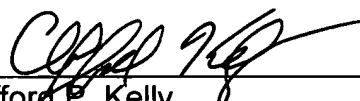
First, there is no logical basis for the allegation that an “activation interface” is explicitly or inherently a “control module”. There is certainly no teaching in Imaizumi that such a control module is present. With respect to inherency, “[t]he fact that a certain result

or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 "The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency]." In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, "... the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." (emphasis in original). Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). It is not inherent in the nature of an "activation interface" that would support the allegation that such interface was also a "control module"

Second, claim 1 also recites "a first service cable assembly electrically connecting the control module to the light source and the intervention energy source". The "activation interface" cited in the Office Action is not located such that it is electrically connected to both the light source and the laser.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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